and are separately usable. *See* item 3 on page 2 of the Office Action. Accordingly, election of one of the above claim groups I-III is required. Applicants respectfully traverse this restriction requirement.

In general, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. M.P.E.P. § 803. As discussed below, the present Office Action has failed to properly establish that the claims of groups I-III are independent or distinct. Further, a serious burden would not be placed on the Examiner if the restriction between these groups of claims is not required.

Restriction between Groups I and II is improper

Applicants fail to understand why claims 12-23 (group II) have been classified as drawn to different subject matter than that identified for claims 1-11 and 24-70 (group I). The present Office Action contends that claims 1-11 and 24-70 (group I) are drawn to a computer for repricing an electronically received reimbursement claim. Claim 1, for example, recites "A computer implemented method of repricing an electronically received reimbursement claim under at least one contract". Similarly, claim 12 recites "A computer implemented method of repricing at least one electronically received reimbursement claim, for medical services, under at least one contract comprising providing programming code for ...". Thus, as with claim 1 (of group I), claim 12 is directed to a computer implemented method of repricing an electronically received reimbursement claim under a contract. While claim 12 specifies that the received claim for reimbursement is for medical services, claim 12 is directed to a repricing method, just as claim 1.

Accordingly, claims 1 and 12 are not drawn to subcombinations that are usable together, but are instead both drawn to repricing methods. For instance, the repricing method of claim 1 may be used for repricing a reimbursement claim for medical services, just as with claim 12. Therefore, Applicants respectfully submit that distinctness as between claim groups I and II has not been properly established.

Additionally, if "the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes

claims to independent or distinct inventions." M.P.E.P. § 803. The Office Action fails to adequately establish that such a serious burden would arise in the present case if the restriction is not made. First, claims 1 and 12 have been previously searched and examined prior to the filing of the Request for Continued Examination (RCE) on June 14, 2004. Thus, because these claims have been examined together, Applicants respectfully submit that no serious burden would arise these claims remaining together in the continued examination of the present application.

Additionally, as explained further below, like elements to those required to be searched and examined for the provisionally elected group of claims (group I) are also present in claim 12 (of group II). For instance, similar elements to those recited in claim 12 (of group II) are found in claim 1 (of group I), and therefore a search and examination of these similar elements will be required anyway.

For example, the first element of claim 12 recites "inputting into a platform, each contract, of the at least one contract, each contract containing a contract identifier code and a series of contractual terms, each contractual term being defined by qualification codes, calculation codes and at least one priority note". Claim 1 recites "providing programming code for converting each contract into a plurality of terms and a contract identifier code, each term, of the plurality of terms, containing qualification codes, calculation codes and at least two priority notes, and arranging the plurality of terms, of said contract, into a sequential series of terms". Thus, each of claims 1 and 12 will require a search and examination of a contract that contains a contract identifier code and a series of contractual terms that each define/contain qualification codes, calculation codes, and a priority note (claim 12 recites "at least one priority note", while claim 1 recites "at least two priority notes").

The second element of claim 12 recites "inputting into a platform, each claim, of the at least one claim, each claim containing a second identifier code and a series of claim lines, wherein each claim line being defined by a claim code, a unit number and a corresponding charge". Claim 1 recites "providing programming code for converting the reimbursement claim into a series of claim lines, each claim line containing a claim code, a unit number and a corresponding charge". Thus, each of claims 1 and 12 will require a search and

examination of a claim that includes a series of claim lines that are each defined by/contain a claim code, a unit number, and a corresponding charge.

The third element of claim 12 recites "requesting a platform to reprice a claim, of the at least one claim, by determining a reimbursement amount for said claim". Claim 1 recites "providing programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms". Thus, each of claims 1 and 12 will require a search and examination of determining a reimbursement amount for a claim.

Claim 12 further recites "requesting a platform to display the reimbursement amount for said repriced claim." Claim 1 does not recite a similar element. However, independent claim 24, which is also included in group I with claim 1, recites "causing a computer to graphically display the reimbursement amount of the repriced claim".

In view of the above, very similar elements are required to be searched and examined in claim 12 of group II as are present in the claims of provisionally elected group I. Accordingly, Applicants respectfully submit that no serious burden exists if the claims of group II are not restricted from those of group I, and therefore the restriction requirement as between groups I and II should be withdrawn.

<u>Restriction between Groups I and III is improper</u>

The present Office Action also asserts that claims 71-86 (group III) are drawn to computer-executable code for generating a user interface. While claim 71 recites "Computer-executable software code stored to a computer-readable medium, the computer-executable software code comprising: code for generating a user interface ...", other claims in group III are not drawn to generating a user interface. Claim 84, for example, recites:

> A method for determining a reimbursement amount for a claim, comprising:
> defining a reimbursement contract in computer-executable program code stored to a computer-readable medium, where said definition of said reimbursement contract includes information associating at least one term of the contract with at least one qualifier having a corresponding calculation method;
> receiving into a processor-based device, information about a claim

received for reimbursement; and
> said processor-based device determining a reimbursement amount for
the claim based at least in part on the defined reimbursement contract.

Thus, claim 84 of group III is not drawn to computer-executable code for generating a user interface, but is instead directed to a method for determining a reimbursement amount of a claim, similar to those claims of group I. Accordingly, at least claim 84 and claims 85-86 (which depend from claim 84) of group III should not be restricted from the claims of group I.
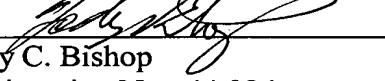
Conclusion

In view of the above, Applicants provisionally elect the claims of group I (claims 1-11 and 24-70), but traverses the restriction requirement of the present Office Action as improper. Applicants respectfully request reconsideration and withdrawal of the outstanding restriction requirement.

Applicants believe no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 66729/P017US/10405597 from which the undersigned is authorized to draw.

Dated: October 19, 2004   Respectfully submitted,

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